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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/043,649	01/10/2002	Helena Mancebo	A-70219-1/RMS/DHR	6039
20350	7590	06/15/2005	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			DIBRJNO, MARIANNE NMN	
			ART UNIT	PAPER NUMBER
			1644	

DATE MAILED: 06/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/043,649	MANCERO ET AL.	
	Examiner	Art Unit	
	DiBrino Marianne	1644	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 17-19 is/are pending in the application.
- 4a) Of the above claim(s) 4 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 17-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. Applicant's amendment filed 3/28/05 is acknowledged and has been entered.
2. Applicant is reminded of Applicant's election with traverse of Group I (claims 1-3 and 5), drawn to a SLIM nucleic acid encoding a SLIM protein that is able to bind Cb1 in Applicant's response filed 8/27/04.

Accordingly, claim 4 (non-elected Group II) remains withdrawn from further consideration by the Examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claims 1-3 and 5 and newly added claims 17-19 are currently being examined.

The following is a new ground of rejection necessitated by Applicant's amendment filed 3/28/05.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-3, 5 and 17-19 are rejected under 35 U.S.C. 102(e) as being anticipated by US 2004/0039163A1 as evidenced by an alignment of best local similarity "Result 3", admissions in the specification on pages 2-3 at the spanning sentence, page 7 at lines 34-37, page 62 at lines 11-12 and page 63 at lines 6-20 and 30-32, and by Holland et al (J. Exp. Med. 194(9), 11/5/01, pages 1263-1276, IDS reference), by admissions in the specification on page 63 at lines 30-32 and page 57 at line 38 continuing on to page 58 at line 1 and Figure 2A, and by Alberts et al (Molecular Biology of the Cell 2nd Ed., Garland Publishing, NY, 1989, pages 55 and appendix page).

US 2004/0039163A1 discloses nucleic acid molecule SEQ ID NO: 74, nucleic acid nucleotides 398-1180 of which are 99.8 % identical to the nucleic acid molecule SEQ ID NO: 2 of the instant application, said art nucleic acid molecule meeting the claim 1 limitation "comprising a nucleic acid sequence having at least about 95% identity to the nucleic acid sequence set forth in Figure 2A (SEQ ID NO: 1)". US 2004/0039163A1 discloses expression vectors containing the nucleic acid sequence, host cells comprising them and methods of culturing the host cells to produce the protein product of the nucleic acid sequence (especially [0489]-[0499]). As pertains to the recitation of "wherein said SLIM protein lacks a tyrosine kinase domain" in claim 2, since the protein

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encoded by SEQ ID NO: 74 is identical to SEQ ID NO: 2 of the instant application with one amino acid difference (Ala to Gly at position 88 of the protein by means of GCC to GGC at nucleic acid 263) the limitation is an inherent property of the reference protein. In addition, as regards the recitation of "will bind to Cb1" in claim 1, the single amino acid difference at position 88 of SEQ ID NO: 2 versus the 398-1180 subsequence of SEQ ID NO: 74 of the art reference is not within the 67 C-terminal amino acid residues of SEQ ID NO: 2 that contain the Cb1 binding sequence as evidenced by admissions in the specification below, so it is an inherent property of the art peptide that it would bind Cb1. With regard to the recitation in claim 1 that SLIM protein comprises an N-terminal myristylation sequence and N-terminal SH3 domain, the said amino acid difference is not in the N-terminal region where the myristylation sequence and SH2 domains reside as evidenced by admissions in the specification below, so it is an inherent property of the art peptide that it would bind Cb1. With regard to the limitation in claim 1 that the SLIM protein comprises an N-terminal SH3 domain, the substitution of Ala to Gly at position 88 is a conservative substitution as evidenced below by admissions in the specification and by Alberts et al, therefore, the claimed process appears to be the same or similar to the process of the prior art absent a showing of unobvious differences. Since the Patent Office does not have the facilities for examining and comparing the process of the instant invention to those of the prior art, the burden is on Applicant to show an unobvious distinction between the process of the instant invention and that of the prior art. See *In re Best*, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977).

An alignment of best local similarity "Result 3" shows that nucleotides 398-1180 of SEQ ID NO: 74 are 99.8% identical to SEQ ID NO: 2 of the instant application.

The admissions in the specification on pages 2-3 at the spanning line, page 7 at lines 34-37, page 62 at lines 11-12 and page 63 at lines 6-20 and 30-32, Figure 2A, and on page 63 at lines 30-32 and page 57 at line 38 continuing on to page 58 at line 1 are that SLIM is referred to as SLAP-2, SLIM (SEQ ID NO: 2) has SH2 and SH3 domains, that the open triangles in Figure 2A are indicative of the boundaries of the SH3 domain and the solid triangles are indicative of the boundaries of the SH2 domain, the Alanine at position 88 of SEQ ID NO: 2 is within the SH3 domain, SLIM contains an N-terminal consensus motif for myristylation, and SLIM binds to Cb1, SLIM-ΔC is a C-terminal truncation variant (67 amino acid residues deleted) that does not bind C1b, respectively.

Holland et al teach the nucleic acid molecule that encodes SLAP-2, the SLAP-2 protein contains an NH2-terminal myristylation consensus sequence and SH3 and SH2 Src homology domains, but lacks a tyrosine kinase domain and binds Cb1.

Alberts et al teach that Glycine and Alanine are both small nonpolar amino acid residues that differ by one CH₃ group in that a hydrogen of the alpha carbon of Glycine is substituted with a CH₃ side chain in Alanine (page 55), and that GCC is a codon for Alanine and GGC is a codon for Glycine (unnumbered appendix page)

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Applicant's arguments in the amendment filed 3/28/05 have been fully considered, but are not persuasive.

Applicant's arguments are of record in the said amendment on pages 15-16 of section "E".

It is the Examiner's position that the claims recite a nucleic acid molecule *comprising* a nucleic acid sequence that has at least about 95% identity to the nucleic acid sequence of SEQ ID NO: 1, and the art reference teaches a nucleic acid molecule that *comprises* a nucleic acid sequence (nucleotides 398-1180 of SEQ ID NO: 74) that has 99.6% identity with SEQ ID NO: 1 of the instant claims, and so meets the claim limitation. In addition, it is the Examiner's position that the sequence alignment between 87919652 (i.e., SEQ ID NO: 74) and SEQ ID NO: 1 in Applicant's Appendix C is an alignment in which portions of SEQ ID NO: 1 containing gaps, rather than contiguous sequence of SEQ ID NO: 1, are aligned with portions of 87919652 containing gaps, rather than contiguous sequence of 87919652. It is the Examiner's further position that the art nucleic acid molecule comprises a nucleic acid sequence that has the recited % identity and the recited N-terminal domains, and identical sequence for binding Cb1, and so encodes a SLIM protein.

5. No claim is allowed.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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7. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Marianne DiBrino whose telephone number is 571-272-0842. The Examiner can normally be reached on Monday, Tuesday, Thursday and Friday.

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Christina Y. Chan, can be reached on 571-272-0841. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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